



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,934	12/01/2000	Thomas J. Keller	1-21737	2820

4859 7590 11/05/2003

MACMILLAN SOBANSKI & TODD, LLC
ONE MARITIME PLAZA FOURTH FLOOR
720 WATER STREET
TOLEDO, OH 43604-1619

EXAMINER

POE, MICHAEL I

ART UNIT	PAPER NUMBER
----------	--------------

1732

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,934

Applicant(s)

KELLER, THOMAS J.

Examiner

Michael I Poe

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1732

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to a method for re-shaping a coating applied to a surface of a component, classified in class 264, subclass 293.
 - II. Claims 10-17, drawn to a tool for re-shaping a coating applied to a surface of a component, classified in class 118, subclass 112.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed could be practiced by another materially different apparatus wherein the sleeve does not engage the arms of the collet directly.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with applicant's attorney Richard MacMillan on August 20, 2002, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

5. The formal drawings were received on May 1, 2001. These drawings are acceptable and approved by the examiner.

Specification

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the instant case, the abstract exceeds 150 words and should be reduced in length in response to this Office action.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 includes the recitation "wherein said step (a) is performed by providing a coating adjusting mechanism a wheel that is rotatably supported on said arm". This recitation is generally confusing because it appears to be missing word(s). Specifically, some word(s) should be included between "a coating adjusting mechanism" and "a wheel". Based upon the applicant's original disclosure, it appears to the examiner that the applicant was attempting to claim that the coating adjusting mechanism is a wheel that is rotatably supported on the arm of the collet. Therefore, for the purpose of

Art Unit: 1732

this Office action, the examiner has assumed that the above recitation was intended to read "wherein, in step (a), said coating adjusting mechanism is a wheel that is rotatably supported on said arm".

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain Patent No. 1,220,058 (Nicholson et al.) in view of U.S. Patent No. 5,330,203 (Fleenor et al.).

Claims 1-4 and 6-9

Nicholson et al. teach a method of embossing (re-shaping) a plastic surface of a body made wholly or partly of plastics material such as a rubber or rubber-like covering (a coating) of an electric cable (component) including feeding a cable core 11 between a pair of embossing wheels 15 (coating adjusting mechanism; said coating adjusting mechanism is a wheel) running on upper and lower parts of the covering 12 and forcing the embossing wheels 15 to bear down on the covering by means of counterweights 21 attached to the embossing wheels 15 (move the coating adjusting mechanism into engagement with the coating applied to the surface of the component) by means of spindles 18 and an arms 19 (an arm that carries a coating adjusting mechanism; rotatably supported on said arm; a plurality of arms, each of which carries a coating adjusting mechanism) (page 1, lines 9-23; page 3, lines 8-34; Figure 2). As illustrated in Figure 1, the embossing wheel may include a circumferentially extending land 7 (a wheel that has a protrusion formed on an outer circumferential surface thereof; a wheel that has a circumferentially extending ridge formed on an outer circumferential surface thereof).

Although Nicholson et al. teach the basic claimed process, Nicholson et al. does not teach that the means for applying pressure to the embossing wheels 15 via the arms 19 is a collet mechanism. However, Fleenor et al. teach a collet 2 for holding a molding tool 1 in a central cavity located therein

Art Unit: 1732

(disposing the collet about the surface of the component) comprising a base 20 (an end portion); a pair of diametrically opposed arms 21 extending longitudinal from the base 20; tightening means for forcing the distal ends of arms 21 toward each other comprising a collet sleeve 3 which is slidable along a longitudinal axis of the collet 2; a locking mechanism for preventing independent rotation of a tool supported in the collet (a collet having an alignment mechanism adapted to engage the component for aligning); and a threaded portion 25 on the base 20 for engaging a drawing nut 4 whereby the collet can be drawn against the sleeve 3 by tightening the drawing nut 4 (disposing a sleeve about the collet so as to move the arms into engagement with the surface of the component; providing a collet having a threaded surface, wherein said step (c) is performed by threading a nut onto the threaded surface of the collet to engage the sleeve so as to move the arms into engagement with the surface of the component) (column 3, lines 9-35 and 61-65). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to converge the arms and to force the embossing wheels against the covering in the process of Nicholson et al. using the collet mechanism taught by Fleenor et al. to provide a more easily adjustable method of forcing the embossing wheels into the surface of the covering to effect embossing.

Note that, in the process of Nicholson et al. in view of Fleenor et al. as set forth above, the collet and the sleeve would have obviously remained stationary as the covering of the electrical cable was moved therethrough. Therefore, the collet and sleeve would have obviously been moved relative to the covering such that the embossing wheels engaged and re-shaped the covering along the surface of the electrical cable.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain Patent No. 1,220,058 (Nicholson et al.) in view of U.S. Patent No. 5,330,203 (Fleenor et al.) and U.S. Patent No. 5,238,642 (Benquet et al.).

Claim 5

The discussion of Nicholson et al. and Fleenor et al. as applied to claim 2 above applies herein.

Nicholson et al. in view of Fleenor et al. do not specifically teach that the embossing wheel may have a plurality of circumferentially extending ridges formed on an outer circumferential surface thereof.

Art Unit: 1732

However, Benquet et al. teach a method for producing engraved markings on a material in the manufacture of a flexible tube wherein the engraved markings are produced by embossing the tube with an embossing roller 1 having a plurality of circumferential rows of pyramidal points 3 (a wheel that has a plurality of circumferentially extending ridges formed on an outer circumferential surface thereof) (Figures 1 and 3). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to provide a plurality of ridges in the process of Nicholson et al. in view of Fleenor et al. as taught by Benquet et al. to provide a plurality of decorative or functional grooves on the surface of the covering of the electrical cable.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. RE27,068 (Groves et al.), U.S. Patent No. 4,528,148 (Dotti), U.S. Patent No. 4,552,544 (Beckman et al.), U.S. Patent No. 5,720,102 (McClanahan), Soviet Patent Publication No. SU 1398990 A (Goroshko et al.) and Japanese Patent Publication No. 04-010938 A (Kenji et al.) have been cited of interest to show the state of the art at the time the invention was made.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael I Poe whose telephone number is (703) 306-9170. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianne can be reached on (703) 305-5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael Poe/mip



**MICHAEL COLAIANNI
PRIMARY EXAMINER**